

REMARKS

This response is timely filed as it is accompanied by a Petition for a Two-Month Extension of Time and the requisite fee therefore, thereby extending the response date to May 16, 2005.

Amendments and Status of Claims

By this amendment, claims 7-16 are added. These claims are clearly supported by the application as originally filed and thus no new matter has been added. Claim 5 has been previously canceled. As a result, claims 1-4, and 6-16 are pending and at issue in the application.

Thus, as a result of this amendment, 15 total claims and two independent claims are currently pending in the application. Because the number of total claims is less than 20 and the number of independent claims is less than three, which is the number of claims paid for with the filing fee, applicant submits that no fee is due for this amendment.

Additionally, Figure 7 is added in this application and the Brief Description of the Drawings section of the specification is amended to include a specific reference to Figure 7. Added Figure 7 and the added specification language are identical to Figure 7 and the specification language originally filed as part of the parent application, U.S. Patent Application Serial No. 10/393,346, to which this application claims priority under 35 U.S.C. § 120. Thus, these amendments are made merely to incorporate information in this

AMENDMENTS TO THE DRAWINGS

Please amend the drawings by adding Figure 7 provided in the New Sheet included herewith. Added Figure 7 is identical to Figure 7 originally filed in the parent application, U.S. Application Serial No. 10/393,346, to which this application claims priority.

application that was originally within the parent application, but that was inadvertently omitted upon the filing of this application.

Because the parent application was expressly incorporated by reference in this application in a statement within the filing papers submitted at the filing of this application (see Utility Patent Application Transmittal, Section 18, filed September 29, 2003), and because the elements of Figure 7 are discussed in this application as originally filed (see, for example, page 8, paragraph 4 of the present application as originally filed), no new matter is being added by these amendments. See, MPEP 201.06(c). (A copy of the parent application is also enclosed herewith.)

Still further, 37 C.F.R. § 1.57 provides that portions of the specification and drawings which were inadvertently omitted from an application but which were completely present in a parent application to which priority was claimed at the filing of the application are automatically incorporated by reference in the application, and therefore may be added at a later date without being considered new matter. For these reasons, the examiner is respectfully requested to enter these amendments.

Information Disclosure Statements

Applicant also includes herewith a Second Supplemental Information Disclosure Statement (IDS) and the requisite therefor for consideration of the information cited in this Second Supplemental IDS. This Second Supplemental IDS cites additional information that has recently come to the attention of the applicant, some of which has been cited during prosecution of the parent application.

Additionally, applicant notes that the examiner has not initialized the Form PTO/SB/08a/b submitted in the Supplemental Information Disclosure Statement (IDS) mailed by the applicant on November 3, 2004, although it appears that the examiner has considered the information in this IDS, as the examiner has relied upon one of the documents submitted in this IDS (namely, the DE 35 12 644 A1 document). As a result, the examiner is respectfully requested to consider the information in the Supplemental IDS to the extent the examiner has not already done so, and to initialize and return the Form PTO/SB/08a/b to the applicant in the next paper. For the examiner's convenience, a copy of the Supplemental IDS and Form PTO/SB/08a/b mailed by the applicant on November 3, 2004 is included herewith.

Moreover, applicant includes herewith an English language translation of the DE 35 12 644 A1 document which the applicant has recently obtained, for consideration by the examiner.

Authorization to Charge Deposit Account

While checks for each of the fees discussed above are included herewith, the Commissioner is hereby authorized to charge any deficiency in the amount enclosed or any additional fees which may be required during the pendency of this application under 37 C.F.R. § 1.16 and § 1.17 to Deposit Account No. 13-2855. A copy of this transmittal is enclosed herewith. Additionally, please refund any overpayment to Marshall, Gerstein & Borun LLP at the address below.

Prior Art Rejections

Applicant respectfully traverses the rejection of claims 1-4 and 6 as obvious over DE 35 12 644 A1 ("Bartels & Rieger") in view of one or more of U.S. Patent No. 5,018,518

(“Hubner”), U.S. Patent No. 4,590,951 (“O’Conner”) and EP 0 241 188 A1 (“Hilton”).

Applicant respectfully requests reconsideration and withdrawal of the rejections.

Each of the claims at issue recites a breathing apparatus including a tank adapted to contain air under pressure, a regulator coupled to the tank to enable delivery of the pressurized air to a user, a filter or a filter system adapted to enable ambient air to pass through a filter medium, a powered air flow unit or moving means that forces ambient air into the filter system, through said filter medium and into operative relationship with a user of the apparatus, a valve assembly operatively associated with the filter system and the tank to control the flow of cleaned air from said filter system or fresh air from the tank and a switch associated with the powered air flow unit or moving means that controls energization of the powered air flow unit or moving means in conjunction with the operation of the valve assembly. Thus, each of the claims at issue basically recites a breathing apparatus having dual sources of air (including pressurized or stored air, and cleaned or filtered ambient air provided with the use of an air flow unit or moving means, such as a motor, a fan, a pump, etc.) The recited breathing apparatus also includes a valve assembly that controls the flow of air to the user from one or both of the dual air sources, in conjunction with a switch that controls operation or energization of the air flow unit in conjunction with the operation of the valve assembly, e.g., in conjunction with the position of the valve assembly. None of the cited art discloses or suggests a breathing apparatus having dual sources of air in which one of the sources of air is a powered filtered air mechanism that includes a switch to effect the operation of the powered unit in conjunction with the operation of a valve that controls which source of air to connect to the user.

While Bartels & Rieger discloses a breathing apparatus having a source of pressurized or stored air and a filter that filters ambient air, the Bartels & Rieger system does not use a powered air flow unit or a means adapted to move ambient air, such as a motorized fan or pump, much less a switch that energizes the powered air flow unit or moving means in conjunction with the operation of a valve that controls the flow of air to a user from one or both of the tank and the filter. Instead, the Bartels & Rieger system uses a non-powered filter mechanism, such as a conventional, manually operated filter. This non-powered filter mechanism relies solely on the user's lungs to produce the negative pressure that sucks air through the filter mechanism to be breathed by the user. In fact, Bartels & Rieger teaches away from using a powered mechanism, as Bartels & Rieger specifically states that it is desirable to have the breathing apparatus be as small and light as possible (see, Translation, page 3, paragraph 5). The addition of the weight of a powered air source, such as a fan motor and fan assembly, would increase the weight of the Bartels & Rieger system thereby rendering it less useful or desirable according to the stated purpose of Bartels & Rieger. In any event, because Bartels & Rieger does not disclose the use of a powered filtered air source, it cannot disclose or suggest the use of a switch of any sort that energizes the powered air source, much less that does so in conjunction with the valve assembly that controls the flow of air from the stored air source and/or the filtered air source.

Hubner fails to disclose a breathing apparatus having two sources of air, much less one having a switch that controls the operation of a powered filtered air source in conjunction with the operation of a valve assembly. In particular, Hubner discloses a conventional and known powered air filter mechanism having a motor that assists the flow of air through a

filter. However, Hubner does not disclose or suggest that this mechanism can or should be used, in any manner, with a source of pressurized or stored air, much less that it might be possible, advantageous or otherwise desirable to have a switch for the powered air filter mechanism operate in conjunction with a valve that controls air flow from one or both of a source of pressurized air and a source of filtered air.

Similar to Hubner, O'Conner merely discloses a powered filtered air respirator that does not include a source of stored or pressurized air. Therefore, for the reasons discussed above with respect to Hubner, O'Conner does not disclose or suggest a switch for a powered air filter mechanism that operates in conjunction with a valve that controls air flow from one or both of a source of pressurized air and a source of filtered air.

Still further, Hilton fails to disclose or suggest the use of switch within a dual source breathing apparatus. While the Hilton system includes a powered filtered air mechanism, this powered filter air mechanism is always on to assure a positive air pressure at the mask of a user. Because the powered unit of the Hilton system is always on, and in fact is always needed to be on to obtain the advantage disclosed in the Hilton document, Hilton does not disclose or suggest a switch that controls a powered filtered air mechanism to operate in conjunction with a valve that controls air flow from one or both of a source of pressurized air and a source of filtered air.

It is clear that the prior art must make a suggestion of or provide an incentive for a claimed combination of elements to establish a *prima facie* case of obviousness. *See, In re Oetiker*, 24 U.S.P.Q.2d 1443, 1446 (Fed. Cir. 1992); *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. 1985). This principle holds true even if the applied art could be modified to

produce the invention recited by the pending claims. *See, In re Mills*, 16 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 1990); *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) ("The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.") Because each of Bartels & Rieger, Hubner, O'Conner and Hilton fails to disclose or provide any motivation for using a switch for a powered filtered air mechanism to operate in conjunction with a valve that controls air flow from one or both of a source of pressurized air and a source of filtered air, it follows that none of these documents can render any of the claims at issue obvious.

Obviousness-Type Double Patenting Rejection

Applicant respectfully traverses the rejection of claims 1-4 and 6 for obviousness-type double patenting over the parent application, U.S. Patent Application Serial No. 10/393,346. Reconsideration and withdrawal of the rejection is respectfully requested.

First of all, applicant submits that the obviousness-type double patenting rejection is now moot, as the claims in the present application include a limitation (i.e., the switch that energizes the air flow unit or moving means in conjunction with the valve assembly) not found in the claims of the parent application, and which makes these claims non-obvious for at least the reasons stated above with respect to the cited prior art. That is, the claims of the present application are no longer "generic" claims with respect to "species" claims found in the parent application. The obviousness-type double patenting is therefore not proper.

Additionally, applicant submits that, if the claims of the present application are "generic" claims to "species" claims found in the parent application, an obviousness-type double patenting rejection is still improper in the present application pursuant to MPEP §

1490. In particular, MPEP § 1490 states that, where two applications have the same priority date (as is the case in this situation in which both the present application and the parent application have the same effective filing date), an obviousness-type double patenting rejection is not properly applied to the application which claims the “base” (i.e., generic) invention. Instead, the obviousness-type double patenting rejection is properly applied to the application which claims the additional limitations. In particular:

If both applications are filed on the same day, the examiner should determine which application claims the base invention and which application claims the improvement (added limitations). The ODP [obviousness-type double patenting] rejection in the base application can be withdrawn without a terminal disclaimer, while the ODP rejection in the improvement application cannot be withdrawn without a terminal disclaimer. MPEP § 1490 (p. 1400-95) (Emphasis in original).

In this case, applicant submits that the present application is the base application as the broadest claims of the present application contain fewer limitations than the claims now present in the parent application. In fact, the examiner has indicated as much in the Office Action. For this further reason, the obviousness-type double patenting rejection is improper in this case.

For these reasons, applicant submits that the examiner should withdraw the obviousness-type patenting rejection in this case.

Applicant's Interview Summary Record

On or about February 9, 2005, one of applicant's attorneys, Richard Anderson, conducted an in-person interview with Examiner Lewis. During this interview, the cited art and the above-identified amendments to claim 1 were generally discussed, and it was

applicant's understanding that the examiner agreed that the addition of the switch element to claim 1 should patentably distinguish this claim over the cited art. Additionally, applicant's attorney generally discussed the obviousness-type double patenting rejection and pointed out the section of the MPEP indicating that such a rejection in this case is improper. Applicant wishes to thank Examiner Lewis for his generosity and courteousness in granting and conducting the interview, and for his assistance in moving this case towards allowance.

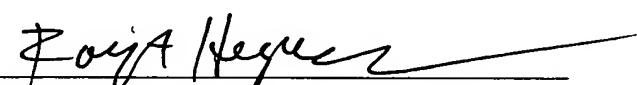
CONCLUSION

For the foregoing reasons, applicant respectfully requests reconsideration and withdrawal of the rejections and allowance of claims 1-4 and 6, and allowance of claims 7-16. If there are matters that can be discussed by telephone to further the prosecution of this application, applicant respectfully requests the examiner to call its attorney at the number listed below.

May 16, 2005

Respectfully submitted,

By:


Roger A. Heppermann
Registration No. 37,641
MARSHALL, GERSTEIN & BORUN LLP
6300 Sears Tower
233 South Wacker Drive
Chicago, Illinois 60606-6402
312-474-6300